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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,412	02/13/2001	Gary P. Mousseau	1400-1072 D5	3123
54120 7590 04/28/2009 RESEARCH IN MOTION ATTN: GLENDA WOLFE BUILDING 6, BRAZOS EAST, SUITE 100 5000 RIVERSIDE DRIVE IRVING, TX 75039				
EXAMINER				
STRANGE, AARON N				
ART UNIT		PAPER NUMBER		
2448				
NOTIFICATION DATE		DELIVERY MODE		
04/28/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[portfolioprossecution@rim.com](mailto:portfolioprossecution@rim.com)

# Office Action Summary

**Application No.**

09/782,412

**Applicant(s)**

MOUSSEAU ET AL.

**Examiner**

AARON STRANGE

**Art Unit**

2448

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 65-78 and 97-118 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 65-78 and 97-118 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. In the interest of expedited prosecution, the Examiner would like to recommend conducting an interview prior to filing a response to the present Office action. The Examiner feels that an interview would help foster a mutual understanding of the respective positions of Applicant and the Examiner, and assist in the identification of allowable subject matter and/or issues for appeal. If Applicant agrees that an interview would be beneficial, he/she is encouraged to contact the Examiner to schedule one.

### ***Terminal Disclaimer***

2. The terminal disclaimer filed on 2/16/2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent Application No. 09/782,107 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Response to Arguments***

3. With regard to claim 65, and Applicant's assertion that Tello "does not teach or suggest a first address of the user that is associated with the host system" (Remarks 23-25), the Examiner respectfully disagrees. As an initial matter, it is noted that the language "associated with" is very broad and requires a minimal relationship between the host system and the first address to be anticipated. The well-known name address taught by Tello is associated with the ISP's mail server, which is analogous to the server 115 in Eggleston, which also processes electronic messages for the user. When

considered in combination, Eggleston and Tello teach a first and second address associated with the user, wherein the first address is associated with a host device such as an email server and the second address is associated with a mobile device.

4. Applicant's remaining arguments with respect to claims 65-78 and 97-118 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 65, 97 and 108 (as currently amended) are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 71, 84 and 95 of copending Application No. 10/671,162. This is a provisional

obviousness-type double patenting rejection. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim the principal features of common addressing using an outer envelope.

Claims 65, 97 and 108 of the present application additionally include piecemeal delivery of messages, which is known in the art and taught by Eggleston (see rejection of claim 65, below).

Since both claim sets claim substantially the same invention, and the differences between them are old and well known, the claims are not patentably distinct and are provisionally rejected on the ground of nonstatutory obviousness-type double patenting.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 65, 67-70, 89, 97, 99, 108 and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Tello et al. (US 6,381,634) further in view of Hall et al. (US 5,826,023).

9. With regard to independent claim 65, Eggleston disclosed a method of redirecting e-mail messages and message attachments to a user of a mobile data

communication device that is associated with a host system and communicates therewith, the method comprising:

receiving a data item (email) for the user at the host system (server 115) from a sender, the data item including an e-mail message addressed to a first address associated with the user and with the host system and a message attachment (e.g. email message with attachment, Col 8, lines 30-37);

redirecting at least a portion of the e-mail message to the mobile data communication device via a wireless network (e.g. when the user has implemented a filter and only part of the message is sent to the user, see inter alia Col 3, lines 23-26 and Col 10, lines 10-32);

receiving a first command message from the mobile data communication device at the host system requesting more of the data item (i.e. sends the request after receiving partial or summary data for more of the message or all of the message, see inter alia Col 3, lines 29-34 or Col 10, line 57 – Col 11, line 4);

redirecting the message attachment from the host system to the mobile data communication device via the wireless network in response to first command message (i.e. when the user requests all of the message or full transfer of the message, the attachment will also be sent to the user's mobile device, again see inter alia Col 3, lines 29-34 or Col 10, line 57 – Col 11, line 4);

receiving from the mobile data communication device a reply e-mail message (user replies to a message)(col. 3, ll. 35-56); and

sending the reply e-mail message to the sender (col. 3, ll. 46-47).

However, Eggleston fails to specifically disclose that the message is redirected to a second address associated with the user, that the reply message's originating address is configured to be the first address, or that the e-mail message and the reply messages are packaged in outer envelopes for transmission via the wireless network.

Tello discloses a similar system for forwarding e-mail messages from a host system associated with a first e-mail address to a second system associated with a second e-mail address. Tello teaches receiving an e-mail message at a host machine (ISP mail server) associated with a first e-mail address (well-known-name value 505)(col. 4, ll. 43-48; col. 5, ll. 29-33), and redirecting the message to a second address associated with the recipient (well-known-name-value is converted into literal address for redirection)(col. 5, ll. 33-39). Tello further discloses that the user's well-known name address remains unchanged, even if the literal address associated with it changes (col. 5, ll. 56-67), permitting e-mail address portability (col. 5, ll. 58-60). The combined teachings of Eggleston and Tello would have taught and/or suggested using the first address (the well-known name value) as the return address in any reply messages, since it would have maintained the portability of the address, permitting later communications in response to the reply message to reach the user via the SCP system, even if the user's literal address changed in the meantime.

Hall discloses a similar system for transporting an electronic mail message across different network types (Abstract). Hall teaches encapsulating an electronic mail created for transmission via a first network in outer envelopes for transmission over a

second type of network (col. 2, l. 45 to col. 3, l. 8). This would have been an advantageous addition to the system disclosed by Eggleston and Tello since it would have allowed the e-mail and reply messages to be created in the same format and simply tunneled over the wireless network using an outer envelope. This would have advantageously eliminating the need to convert messages between formats used by different networks.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to permit forwarding of messages to a second address associated with the user, and use the first address as the originating address of any subsequent reply messages, to maintain portability of the user's e-mail address and ensure that additional messages in the conversation are sent to the user's current location, as well as to transmit the messages over the wireless network using an outer envelope to eliminate the need to convert message formats for communication over different network types.

10. With regard to claim 67, Eggleston disclosed:

Configuring one or more redirection events at the host system (e.g. user sets up a filter, see inter alia Col 8, lines 14-55);

detecting that a redirection event has occurred at the host system (i.e. an email passes the filter criteria) and generating a redirection trigger (required internally in the system such that the system invokes the process or procedure to actually forward the message); and



In response to the redirection trigger, redirecting at least a portion of the e-mail message from the host system to the mobile data communication device (i.e. forwarding the message when it passes the filter criteria).

11. With regard to claims 68 and 69, Eggleston disclosed the external redirection event is a message from the mobile data communication device to start the redirection step (i.e. user enables the filters from the mobile device, Col 9, lines 32-43). Eggleston also disclosed the internal event includes a calendar alarm (calendar activates a filter profile, Col 9, lines 42-43).

12. With regard to claim 70, Eggleston disclosed the mobile data communication device is one of a hand-held wireless paging computer, a wirelessly-enabled palm-top computer, a mobile telephone with data message capabilities and a wirelessly-enabled laptop computer (Col 4, lines 11-13).

13. Claims 97, 99, 108 and 110 are rejected under the same rationale as claims 65 and 70, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

14. Claims 71-73, 100-102 and 111-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Tello et al. (US 6,381,634) further in view of Hall et al. (US 5,826,023) further in view of Official Notice.

15. With regard to claims 71-73, while the system disclosed by Eggleston in view of Tello shows substantial features of the claimed invention (discussed above), it fails to disclose that the attachment is one of a word processing, audio or video attachment, or whether the attachment is one that can be processed by the mobile device.

The Examiner takes Official Notice that word processing files, audio files, and video files were all old and well known types of email attachments at the time the invention was made, and that word processing type files could be processed (displayed) by mobile devices while video files could not, due to limitations on processing capabilities at the time.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to permit these attachments to be received and processed by the system taught by Eggleston and Tello, since they were commonly accepted email attachments at the time the invention was made.

16. Claims 100-102 and 111-113 are rejected under the same rationale as claims 71-73, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

17. Claims 66, 74-78, 98, 103-107, 109 and 114-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Eggleston et al. (US 5,958,006 in view of Tello et al. (US 6,381,634) further in view of Hall et al. (US 5,826,023) further in view of Official Notice further in view of Kikinis (US 5,964,833).

18. With regard to claims 66 and 74, while the system disclosed by Eggleston and Tello shows substantial features of the claimed invention (discussed above), it fails to disclose receiving a second command message from the mobile data communication device at the host system to send the message attachment to an external device stored in a user profile and redirecting the message attachment from the host system to the external device in response to the second command message.

In a similar messaging system Kikinis disclosed a system that allows users to forward email attachments to various preprogrammed external devices such as a fax machine (Kikinis Col 4, lines 50-56). By allowing users to forward attachments using other devices rather than just email, Kikinis allows users to communicate easier and with more people. For instance an external device such a fax machine may be more convenient for some users or the only form of communication available to other users who are unable to receive email at a particular location.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Eggleston's system to allow users to forward attachments to other preprogrammed external devices, as disclosed by Kikinis, so that

users can communicate with other people by using different means rather than just email and thus communicate with more people.

19. With regard to claim 75, Kikinis disclosed the external device is one of a fax machine (Col 4, lines 50-56).

20. With regard to claim 76, Kikinis disclosed the step of decoupling the message attachment from the e-mail message (i.e. Kikinis only sends the attachment to a fax machine which requires decouple the message attachment from the e-mail message).

21. With regard to claims 77 and 78, Kikinis disclosed the step of storing the e-mail message and message attachment in a message store at the host system (Col 4, lines 38-48).

22. Claims 98, 103-107, 109 and 114-118 are rejected under the same rationale as claims 66, 74-78, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

***Conclusion***

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/  
Examiner, Art Unit 2448